

REMARKS

This response is intended as a full and complete response to the final Office Action mailed December 29, 2004. In the Office Action, the Examiner noted that claims 3-21, 24, 25, 27, 29, 31, 33 and 35 were pending, of which all the pending claims were rejected under 35 U.S.C. §112 and 35 U.S.C. §103.

By this response, Applicants have amended claim 5 to correct a typo. The amendment contains no new matter and is fully supported by Applicants' original specification, including the drawings and claims.

In view of the amendments described above and the following discussion, Applicants submit that the claims pending in the application are believed to be nonobvious under 35 U.S.C. §103. Thus, Applicants believe that the application is in condition for allowance.

It is to be understood that the Applicants, by amending the claims, do not acquiesce to the Examiner's characterizations of the art of record or to the Applicants' subject matter recited in the pending claims. Further, the Applicants are not acquiescing to the Examiner's statements as to the applicability of the art of record to the pending claims by filing the instant responsive amendments.

DRAWINGS

The Examiner has objected to the drawings under 37 C.F.R. 1.83(a). Corrected drawings in compliance with 37 C.F.R. 1.121(d) are submitted herewith. Figure 4 is amended to add a box labeled "Aging channel list" with reference numeral 401. An arrow was added from step 402 to step 401. The arrow from step 422 to step 404 was modified to insert step 401 by splitting it into two arrows, one arrow from step 422 to step 401 and another arrow from step 401 to step 404. This amendment to figure 4 contains no new matter and is supported by Applicants' whole original specification, drawings, and claims, including page 4, lines 7-13. Corresponding to this amendment to Figure 4, the text from Applicants' original specification on page 4, lines 7-13 was added to the paragraph starting at line 11 on page 15, which describes figure 4.

REJECTION UNDER 35 U.S.C. §112

The Examiner has rejected claims 3-21, 24, 25, 27, 29, 31, 33, and 35 under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement.

To establish a *prima facie* case of non-enablement, the Examiner has the burden of showing a rational basis as to why the disclosure does not teach or why to doubt the objective truth of the statements in the disclosure that purport to teach the manner and process of making and using the invention that corresponds in scope to the claimed invention to one of ordinary skill in the pertinent technology without undue experimentation and dealing with subject matter that would not already be known to the skilled person as of the filing date of the application.

Applicants respectfully traverse the rejection, because the Examiner has failed to establish a *prima facie* case of non-enablement. The Examiner generally pointed to the references in Applicants' specification to "one embodiment", "some embodiments" or "other embodiments" on pages 3-4 in connection with an aging process. However, this has no bearing on enablement, because it is not a rational basis as to why the disclosure does not teach or why to doubt the objective truth of the statements in the disclosure that teach the manner and process of making and using the invention. By contrast, this language merely indicates that various embodiments of the present invention are being described in Applicants' specification. The aging process, when considered in the context of Applicants' whole original specification as filed is enabling to one of ordinary skill in the pertinent technology without undue experimentation. For example, page 4, lines 7-13 describe the aging process and how it is used, which corresponds in scope to the claimed invention. It would be clear to one of ordinary skill in the pertinent technology without undue experimentation how the aging process is used in the process of automatically flagging favorite channels as illustrated by Figures 3-5 and described in Applicants' whole original specification.

Applicants respectfully submit that claims 3-21, 24, 25, 27, 29, 31, 33, and 35 are enabled. The Examiner did not specifically reject each claim by indicating why there was any question as to their enablement in particular. Nevertheless, exemplary support is as follows.

Claim 3 is supported by Applicants' whole original specification as filed, including the drawings, and claims. For example, claim 3 is supported by Figure 3, steps 308, 310, and 312 and page 13, line 13 to page 15, line 10.

Claim 4 is supported by Applicants' whole original specification as filed, including the drawings, and claims. For example, claim 4 is supported by Figure 4, steps 406, 408, 410, 416, 418, 420, and 422 and page 15, line 11 to page 17, line 19.

Claim 5 is supported by Applicants' whole original specification as filed, including the drawings, and claims. For example, claim 5 is supported by Figure 4, steps 404, 406, 408, 412, 416, 418, and 420, page 4, lines 7-13, and page 15, line 11 to page 17, line 19.

Claim 6 is supported by Applicants' whole original specification as filed, including the drawings, and claims. For example, claim 6 is supported by Figure 3, Figure 4, steps 408 and 418, page 3, lines 5-17, and page 15, line 11 to page 17, line 19.

Claim 7 is supported by Applicants' whole original specification as filed, including the drawings, and claims. For example, claim 7 is supported by Figures 3 and 4, page 4, lines 3-13, page 14, lines 8-16, and page 16, line 21 to page 17, line 10.

Claim 8 is supported by Applicants' whole original specification as filed, including the drawings, and claims. For example, claim 8 is supported by Figures 3 and 4, page 4, lines 3-13, page 14, lines 8-16, and page 16, line 21 to page 17, line 10.

Claim 9 is supported by Applicants' whole original specification as filed, including the drawings, and claims. For example, claim 9 is supported by Figure 4, steps 406, 408, 410, 412, 414, 416, 418, 420, 422, and 424, page 15, line 11 to page 17, line 19.

Claim 10 is supported by Applicants' whole original specification as filed, including the drawings, and claims. For example, claim 10 is supported by Figures 1 and 2, page 4, lines 19-23, page 10, lines 4-14, and page 11, lines 4-10.

Claim 11 is supported by Applicants' whole original specification as filed, including the drawings, and claims. For example, claim 11 is supported by Figures 1 and 2, page 4, lines 19-23, page 10, lines 4-14, and page 11, lines 4-10.

Claim 12 is supported by Applicants' whole original specification as filed, including the drawings, and claims. For example, claim 12 is supported by Figures 1, 2,

and 5, page 4, lines 19-23, page 10, lines 4-14, page 11, lines 4-10, and page 17 line 20 to page 19, line 12.

Claim 13 is supported by Applicants' whole original specification as filed, including the drawings, and claims. For example, claim 13 is supported by Figures 1, 2, and 5, page 5, lines 1-12, and page 17 line 20 to page 19, line 12.

Claim 14 is supported by Applicants' whole original specification as filed, including the drawings, and claims. For example, claim 14 is supported by Figures 1, 2, and 5, page 5, lines 1-12, and page 17 line 20 to page 19, line 12.

Claim 15 is supported by Applicants' whole original specification as filed, including the drawings, and claims. For example, claim 15 is supported by Figures 1, 2, and 5, page 5, lines 1-12, and page 17 line 20 to page 19, line 12.

Claim 16 is supported by Applicants' whole original specification as filed, including the drawings, and claims. For example, claim 16 is supported by Figures 1, 2, and 5, page 5, lines 1-12, and page 17 line 20 to page 19, line 12.

Claim 17 is supported by Applicants' whole original specification as filed, including the drawings, and claims. For example, claim 17 is supported by Figures 4 and 5, and page 6, line 19 to page 7, line 5.

Claim 18 is supported by Applicants' whole original specification as filed, including the drawings, and claims. For example, claim 18 is supported by Figures 1-5, page 4, lines 7-13, and page 7, line 21 to page 17, line 19.

Claim 19 is supported by Applicants' whole original specification as filed, including the drawings, and claims. For example, claim 19 is supported by Figures 1-5, page 4, lines 7-13, and page 7, line 21 to page 17, line 19.

Claim 20 is supported by Applicants' whole original specification as filed, including the drawings, and claims. For example, claim 20 is supported by Figures 1-5, page 4, lines 7-13, and page 7, line 21 to page 17, line 19.

Claim 21 is supported by Applicants' whole original specification as filed, including the drawings, and claims. For example, claim 21 is supported by Figures 1 and 2 and page 6, lines 14-18.

Claim 24 is supported by Applicants' whole original specification as filed, including the drawings, and claims. For example, claim 24 is supported by page 2, line 14 to page 3, line 4.

Claim 25 is supported by Applicants' whole original specification as filed, including the drawings, and claims. For example, claim 25 is supported by Figure 5 and page 18, lines 4-23.

Claim 27 is supported by Applicants' whole original specification as filed, including the drawings, and claims. For example, claim 27 is supported by Figure 4, page 4, lines 7-13, and page 15, line 11 to page 17, line 19.

Claim 29 is supported by Applicants' whole original specification as filed, including the drawings, and claims. For example, claim 29 is supported by Figure 4, page 4, lines 7-13, and page 15, line 11 to page 17, line 19.

Claim 31 is supported by Applicants' whole original specification as filed, including the drawings, and claims. For example, claim 31 is supported by Figures 1 and 2, page 4, lines 7-13 and 19-23, page 10, lines 4-14, and page 11, lines 4-10.

Claim 33 is supported by Applicants' whole original specification as filed, including the drawings, and claims. For example, claim 33 is supported by Figures 1, 2, and 5, page 4, lines 7-13, page 5, lines 1-12, and page 17 line 20 to page 19, line 12.

Claim 35 is supported by Applicants' whole original specification as filed, including the drawings, and claims. For example, claim 35 is supported by Figures 4 and 5, page 4, lines 7-13, and page 6, line 19 to page 7, line 5.

REJECTIONS UNDER 35 U.S.C. §103

Applicants acknowledge that they have been advised of the obligation under 37 C.F.R. §1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the Examiner to consider the applicability of 35 U.S.C. §103(c) and potential 35 U.S.C. §§102(e), (f) or (g) prior art under 35 U.S.C. §103(a).

The test under 35 U.S.C. §103 is not whether an improvement or a use set forth in a patent would have been obvious or non-obvious; rather the test is whether the claimed invention, considered as a whole, would have been obvious. Jones v. Hardy,

110 USPQ 1021, 1024 (Fed. Cir. 1984) (emphasis added). Moreover, the invention as a whole is not restricted to the specific subject matter claimed, but also embraces its properties and the problem it solves. In re Wright, 6 USPQ 2d 1959, 1961 (Fed. Cir. 1988) (emphasis added). The cited references alone or in combination fail to teach or suggest the Applicants' invention as a whole.

Rejection of Claims 3-8, 18-21 and 27 in view of Candelore and Bates

Claims 3-8, 18-21 and 27 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0104081 of Candelore et al. ("Candelore") in view of U.S. Patent 6,721,953 to Bates et al. ("Bates"). Applicants respectfully traverse these rejections.

A *prima facie* case of obviousness is established when the Examiner provides one or more references that teach a suggestion to combine or modify the references, the combination or modification of which would appear to be sufficient to have made the claimed invention obvious to one of ordinary skill in the art. Applicants respectfully traverse these rejections, because a *prima facie* case of obviousness has not been established.

Candelore fails to teach or suggest each element the claimed invention, because Candelore teaches away from the claimed invention and the stated objectives of Candelore reinforce the fact that it teaches away. The title of Candelore is "Method and System to Maintain Relative Statistics for Creating Automatically a List of Favorites" and these "relative statistics" teach away from the claimed invention. In the abstract, Candelore states that the list of favorites is created based on these "relative statistics" for efficiency, because of limited system resources. In the background, Candelore states:

...to determine how long or how many times a viewer accesses the same channel or program, the TV broadcast system must maintain extensive statistics. Hence, a limitation of current TV broadcast systems is that they have limited resources to store and maintain such statistics. Consequently, if one statistical count is limited to a fixed size, e.g., a byte, the statistical count will roll over at a maximum count of "255." Thus, the statistical data may become inaccurate after a certain count.

(Candelore, page 1, para. 5). Thus, a stated objective in Candelore is to avoid the rollover problem by using relative statistics rather than true or actual counts. However, the claimed invention does, in fact, maintain true or actual counts, without any rollover problem, by using thresholds. Therefore, Candelore teaches away from the claimed invention. The concept of “relative statistics” is further defined in Candelore as follows.

...if the count value is at its maximum count value, all counts related to items in the record are subtracted by the same amount to maintain relative relationship. Alternatively, a relative percentage can be subtracted from the count values.

(Candelore, Figure 6, page 5, para. 50). In figure 7, Candelore shows an example where the so-called “counts” for three items are each reduced by 90%. Thus, the “relative statistics” are not actual or true counts, because when a value is approaching a rollover value, a fixed amount or percentage is subtracted from all the count values, making them relative counts, not true counts. By contrast, the claimed invention uses actual or true counts, not “relative statistics”.

Claim 5 recites, *inter alia*, “determining whether the channel tune count indicator associated with a channel in the list of automatic favorite channels falls below a view threshold value; and removing from the list of automatic favorite channels any identifier whose associated channel tune count indicator falls below the view threshold value.” In other words, the claimed invention maintains true or actual counts, without any rollover problem, by using thresholds.

The Office Action misinterpreted Candelore in a way that is contrary to its stated objectives and the way it teaches away. The Office Action incorrectly cited Candelore (page 4, para. 38 and pages 4 and 5, para. 47) as teaching the above elements of claim 5, while completely overlooking the fact that Candelore keeps “relative statistics”, not true or actual counts, as in the claimed invention. The “count values” for the list of favorites are “relative statistics”, not true or actual counts, as is clear upon reading the entire Candelore reference and its stated purpose. To interpret Candelore otherwise is to thwart its stated purpose.

Candelore fails to teach or suggest a “view threshold value” as in the claimed invention. In addition, Candelore fails to teach or suggest keeping true or actual counts. Furthermore, Candelore teaches away from true or actual counts, by teaching

“relative statistics” and has the stated objective of doing so to avoid the rollover problem. Therefore, Candelore fails to teach or suggest at least these elements of claim 5.

Bates also fails to teach or suggest at least these elements of claim 5 and, thus, fails to fill the gap created by the misinterpretation of Candelore.

Claim 5 is therefore non-obvious over the combination of Candelore and Bates.

Claims 3, 4, 6-8, and 27 depend, directly or indirectly, from claim 5 and, thus, inherit at least the patentable subject matter of claim 5. Therefore, claims 3, 4, 6-8, and 27 are also non-obvious over the combination of Candelore and Bates.

Claim 18 recites, *inter alia*, “determining whether the channel tune count indicator associated with a channel in the list of automatic favorite channels falls below a view threshold value; and removing from the list of automatic favorite channels any identifier whose associated channel tune count indicator falls below the view threshold value.” For the same reasons given above for claim 5, claim 18 is non-obvious over the combination of Candelore and Bates.

Claim 19 recites, *inter alia*, “means for determining whether the channel tune count indicator associated with a channel in the list of automatic favorite channels falls below a view threshold value; and means for removing from the list of automatic favorite channels any identifier whose associated channel tune count indicator falls below the view threshold value.” For the same reasons given above for claim 5, claim 19 is non-obvious over the combination of Candelore and Bates.

Claim 20 recites, *inter alia*, “to determine whether the channel tune count indicator associated with a channel in the list of automatic favorite channels falls below a view threshold value, and to remove an identifier from the list of automotive favorites whose associated channel tune count indicator falls below the view threshold value.” For the same reasons given above for claim 5, claim 20 is non-obvious over the combination of Candelore and Bates.

Claim 21 depends from claim 20 and, thus, inherits at least the patentable subject matter of claim 20. Therefore, claim 21 is also non-obvious over the combination of Candelore and Bates.

Rejection of Claims 9-14, 29, 31 and 33 in view of Candelore, Bates and Ohkura

Claims 9-14, 29, 31 and 33 were rejected under 35 U.S.C. §103(a) as being unpatentable over Candelore in view of Bates and further in view of U.S. Patent 5,737,029 to Ohkura et al. (hereinafter "Ohkura"). Claims 9-14, 29, 31 and 33 are dependent, either directly or indirectly, upon Applicants' independent claim 5. Applicants respectfully traverse the instant rejection.

It has already been discussed above that Candelore and Bates fail to teach, show, or suggest Applicants' method steps as defined in claim 5 as a whole. Similarly, the Ohkura references fail to teach at least Applicants' steps of "determining whether the channel tune count indicator associated with a channel in the list of automatic favorite channels falls below a view threshold value" and "removing from the list of automatic favorite channels any identifier whose associated channel tune count indicator falls below the view threshold value."

Ohkura is concerned with creating an automatic favorites list, and he wants to exclude channels that are viewed for a short duration such as less than five minutes. It is important to note that these are channels that are being excluded from entry onto the favorites list. Ohkura presents no teaching, showing, or suggestion for checking an entry already on the list to determine whether its viewing time is of a short duration. That teaching is only found in Applicants' specification. Therefore, Ohkura, when added to the teachings of Bates and Candelore, falls far short of the invention defined in Applicants' claim 5.

Since claims 9-14, 29, 31, and 33 depend directly or indirectly from claim 5 and since amended claim 5 is believed to be allowable over Candelore, Bates and Ohkura, either alone or in combination, Applicants respectfully submit that claims 9-14, 29, 31, and 33, dependent directly or indirectly from claim 5, are also allowable over these references. Therefore, it is believed that claims 9-14, 29, 31, and 33 are allowable under 35 U.S.C. §103.

Rejection of Claims 13, 15, 16 and 25 in view of Candelore, Noguchi and Bates

Claims 13, 15, 16 and 25 were rejected under 35 U.S.C. §103(a) as being unpatentable over Candelore and Bates in view of to Noguchi et al. (hereinafter

"Noguchi"). The rejected claims depend either directly or indirectly from independent base claim 5. Applicants respectfully traverse the rejection.

As discussed above, Applicants submit that independent claim 5, and therefore the claims dependent thereon, is patentable and non-obvious under 35 U.S.C. §103 in view of Candelore and Bates. Noguchi fails to bridge the substantial gap as between Candelore and Bates and Applicants' invention.

It has already been discussed above that Candelore and Bates fail to teach Applicants' method step of aging as defined in independent base claim 5. As discussed immediately above, Noguchi fails at the outset to teach Applicants' method step of aging as defined in claim 5.

Noguchi teaches a system for displaying an electronic program guide on a monitor, such as a television screen. Noguchi shows a remote control device having a number of different controls, one of which is a "favorites" control. The favorites control allows the user "to designate certain programs as favorite programs." This control also permits "selection of favorite programs." There is no teaching in Noguchi about aging entries in the favorites list when they have not been watched for a certain time period or about determining whether indicators in the favorites list fall below a prescribed threshold or about removing entries from the favorites list if their indicators fall below the threshold, all as taught and claimed by Applicants in the independent base claim. As a result, the addition of Noguchi's teachings to the teachings of Candelore and Bates, even if such addition is properly motivated by the references alone, falls short of teaching, suggesting, or showing Applicants' unique method as a whole.

In light of the remarks presented above with respect to independent base claim 5, it is submitted that the Candelore, Bates and Noguchi patents fail to teach, show, or suggest Applicants' invention as defined in base claim 5 and in dependent claims 13, 15, 16, and 25. As a result, it is submitted that Applicants' claimed invention would not have been obvious to a person having ordinary skill in the art upon a reading of Candelore, Bates, and Noguchi, separately and in combination, at the time the invention was made. Therefore, Applicants believe that dependent claims 13, 15, 16 and 25 are allowable under 35 U.S.C. §103.

Rejection of Claims 17 and 35 in view of Candelore, Bates and McClard

Claims 17 and 35 were rejected as being unpatentable under 35 U.S.C. §103(a) over Candelore and Bates in view of U.S. Patent 6,438,752 B1 to McClard (hereinafter "McClard"). Claims 17 and 35 depend directly and indirectly from independent base claim 5. This rejection is respectfully traversed.

McClard teaches a system for storing and selecting favorite programs tailored for each individual user. As programs are watched, they are placed in a list of favorites. McClard discusses populating the list and selecting programs/channels from the list. But McClard teaches nothing about aging the list as taught and defined by Applicants in claim 5. Moreover, McClard teaches nothing about both determining whether indicators for certain entries on the favorites list fall below a threshold and then removing those certain entries from the list.

It has already been discussed above that Candelore and Bates fail to teach Applicants' method steps as defined in independent base claim 5. As discussed immediately above, McClard fails at the outset to teach Applicants' method as defined in claim 5. As a result, it is believed that the combination of Candelore, Bates and McClard fails to teach, show, or suggest Applicants' claimed invention.

In view of the remarks immediately above and those remarks not repeated herein with respect to Candelore and Bates above, it is respectfully submitted that Applicants' invention as defined by dependent claims 17 and 35, dependent directly or indirectly from amended independent base claim 5, would not have been obvious to a person having ordinary skill in the art upon a reading of Candelore, Bates and McClard, separately or in combination, at the time the invention was made. Therefore, Applicants respectfully submit that claims 17 and 35 are allowable under 35 U.S.C. §103.

Rejection of Claim 24 in view of Candelore, Bates, and Florence

The Examiner rejected claim 24 under 35 U.S.C. §102(e) as being unpatentable over Candelore and Bates in further view of U.S. Patent Application Publication No. 2002/01888948 (hereinafter "Florence"). Claim 24 depends directly from claim 5. Applicants respectfully traverse the rejection.

Florence describes a set top box that is capable of storing channel favorites in a channel favorites table and for displaying the list of stored channel favorites for a viewer. Favorites are based on computed cumulative viewing time. But Florence fails to teach, show, or even remotely suggest aging the favorites list as taught and claimed by Applicants. In addition, Florence fails to teach, show, or even remotely suggest both determining whether indicators for certain entries on the favorites list fall below a threshold and then removing those certain entries from the list.

It has already been discussed above that Candelore and Bates fail to teach Applicants' method as defined in independent base claim 5. As discussed immediately above, Florence fails at the outset to teach Applicants' method as defined in claim 5. Since Florence does not teach, show, or suggest the aging, determining and removing steps, the addition of the teachings of Florence to Candelore and Bates does not cure the infirmities of either Candelore or Candelore and Bates. The combined teachings of Florence, Bates and Candelore fail to teach, show, or suggest Applicants' unique invention.

In view of the remarks above, Applicants respectfully submit that claim 24 would not have been obvious to a person having ordinary skill in the art upon a reading of Candelore, Bates and Florence, separately or in combination, at the time the invention was made. Therefore, Applicants believe that claim 24 is allowable under 35 U.S.C. §103.


CONCLUSION

In view of the foregoing, Applicants respectfully submit that this application is in condition for allowance. Reconsideration of this application and allowance are respectfully solicited.

If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Eamon J. Wall at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

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AMENDMENTS TO THE DRAWINGS